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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,818	08/19/2003	Donald Studer		3092

7590 05/18/2004  
Robert J. Ireland  
POB 273  
Banks, OR 97106

EXAMINER

SZUMNY, JONATHAN A

ART UNIT PAPER NUMBER

3632

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/642,818

Applicant(s)

STUDER, DONALD

Examiner

Jon A Szumny

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 2-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/19/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

This is the first office action for application number 10/642,818, Method for Forming a Hanger for a Chain Link Fence, filed on August 19, 2003.

***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: The hook apparatus of figures 1-5;

Species 2: The hook apparatus of figure 6;

Species 3: The hook apparatus of figure 7

Species 4: The hook apparatus of figure 8

Species 5: The hook apparatus of figure 9

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Robert Ireland on May 13, 2004 a provisional election was made without traverse to prosecute the invention of species 1, claim 1. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### ***Priority***

Domestic priority of application number 60/404,309, filed on August 19, 2002, is acknowledged.

#### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: All reference numerals. A proposed drawing correction, corrected drawings, or

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amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

On page 4, lines 10-11, it is not understood what is meant by "... allowing for any item of assembly to the pop riveted to the second element."

On page 10, line 4, "comprises" should be --comprising--;

On line 9, "having" should be --having a--;

On line 10, "having" should be --having a--;

On line 12, "having" should be --having a--;

Appropriate correction is required.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities:

In line 20, "first" should be --a first--;

In line 22, "second" should be --a second--;

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following subject matter was not described in the specification:

In claim 1, lines 11-12, "...being separated by approximately 1.125 inches...";

In line 17, "staggered";

In lines 19-20, "...having a first notch centered approximately .431 inches...";

In line 21, "...second notch centered approximately .431 inches...";

In lines 24-25, "...enhance engagement of the wire portions...";

In lines 33-34, "...having generally constant width of approximately 2.20 inches.

However, the Examiner will attempt to apply the art as best understood.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the top one" in line 6, "the bottom of the diamond pattern" in line 25-26 and "said other elements" in line 30. There is insufficient antecedent basis for these limitations in the claim.

Further, in line 3, it is stated that the first element is "vertically disposed," and then in line 5 it is stated that the second element is "vertically disposed" and "integral with the first element..." However, in lines 7-8, it is stated that the second element is "...disposed with the first element in an L-shape." How can both the first and second elements be "vertically disposed" if they are disposed in an L-shape?

Continuing, starting in line 13, the applicant recites "a flat fold portion connecting the first and second elements when the first and second elements are in their folded disposition." However, previously, the applicant recited that the first and second elements were integrally connected in an L-shape. Is the flat fold portion a portion of one of the first or second elements? It appears the applicant is changing what is referred to as the second element before and after folding.

Also, it appears that the applicant might be including method steps in this apparatus claim ("...before said first and second elements are folded..." "...when said first and second elements are in their folded disposition..."). This is confusing.

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Finally, it is not clear if the applicant is intending to recite the wire portions of the chain link fence positively or functionally. The preamble of recites the chain link fence functionally ("adapted for use...") but then lines 24-26 recite the chain link, fence positively ("enhance engagement of the wire portions of the chain link fence..."). The applicant must make it clear whether the chain link fence is recited positively or merely functionally. For the purposes of this office action, the Examiner will assume the chain link fence is recited *functionally*.

However, the Examiner will attempt to apply the prior art as best understood.

### ***Claim Rejections - 35 USC § 103***

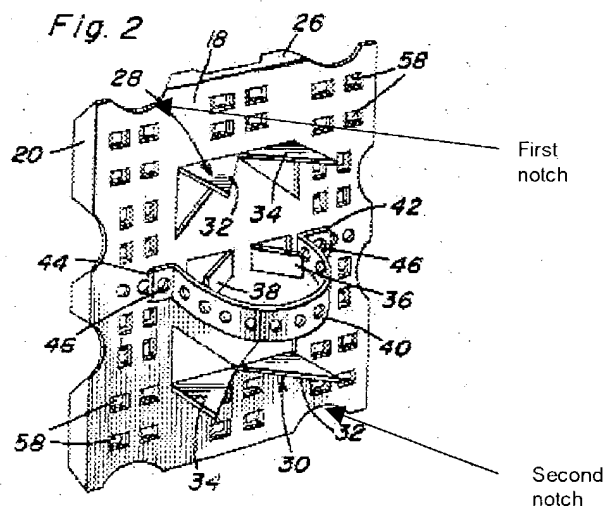
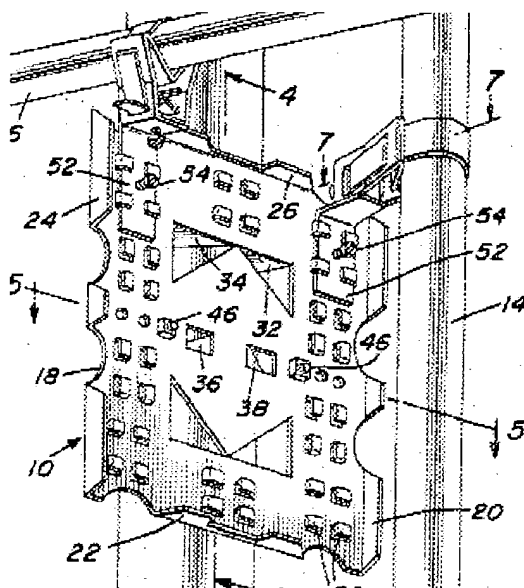
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent number 3,347,505 to Menser.





Menser '505 discloses a hook apparatus (above) comprising a first vertically disposed element (18,20) having two oppositely located end portions (right and left side, respectively), a second vertically disposed element (24) integral with the first element and extending from the top one (inherently the "top" depending upon some user's

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specific reference point) of the said two oppositely located end portions of the first element and disposed with said first element in an L-shape before the first and second elements are folded relative to one another and disposed with said first element in a generally parallel configuration after being folded;

wherein the first and second elements are separated by a distance in their folded position;

wherein a flat fold portion (18) connects the first and second elements when the first and second elements are in their folded disposition, the fold portion being disposed perpendicular relative to a vertical reference and perpendicular to both the first and second elements;

wherein the flat fold portion has opposing staggered notches (above) on the anterior side edge of said flat fold portion;

wherein the staggered notches have a first notch (above) centered a distance from the union of the first element and the flat fold portion and second notch (above) centered a distance from the union of the second element and the flat fold portion, both notches having an internal radius;

wherein the first and second elements and flat fold portion are integral, wherein the second element extends away from the flat fold portion, wherein the elements have a constant width.

However, Menser '505 fails to specifically teach the first and second elements to be separated by approximately 1.125 inches in their folded position, the first notch to be centered approximately .431 inches from the union of the first element and the flat fold

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portion, the second notch to be centered approximately .431 inches from the union of the second element and the flat fold portion; both notches to have an internal radius of .156 inches, and the elements to have a generally constant width of approximately 2.20 inches. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the previously mentioned features of any number of various dimensions, including those as specifically recited because doing so is considered a design choice and hence not considered patentable since the applicant has not specifically recited in the originally filed specification why such a dimension is critical to the invention or produces any unexpected result. See *In re Kuhle*, 526 F.2d 553, 188, USPQ 7 (CCPA 1975).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jankowsky '270, Bedford, Jr. '110, Tinnerman '447, Vollmer '013, Veenstra '284, Braaten '065, Mosteller '817, Mesna et al. '244, Croker '395, Wilson, Jr. '363 and Dean et al. '41 divulge various hangers/brackets with first and second elements and flat fold portions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon A Szumny whose telephone number is (703) 306-3403. The examiner can normally be reached on Monday-Friday 8-4.

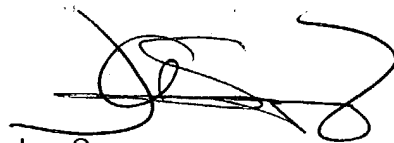
The fax phone number for the organization where this application and proceeding are assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read 'Jon Szumny', with a stylized, looping flourish at the end.

Jon Szumny  
Patent Examiner  
Technology Center 3600  
Art Unit 3632  
May 14, 2004